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PATENT
Dkt. P1535US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Arnold G. Slezak**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **09/981,556** Group Art: **3729**
Filed: **October 17, 2001** Examiner: **Anthony Tugbang**
For: **METHOD TO REDUCE SERVO PATTERN RUNOUT ON A
PREWRITTEN DISC**

Director of the U.S. Patent and Trademark Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition to the Director Under 37 CFR 1.181(a)(2)

Sir:

This Petition is proper and necessary because it is a request that the Director review the restriction requirement made in the Office Action of 4/22/2005, as provided by 37 CFR 1.144. After review, Applicant respectfully requests that the Director intervene in this case to have the restriction requirement either withdrawn or substantiated by legally sufficient evidence in the record. The restriction requirement has been made final, and Applicant has duly requested reconsideration of the restriction requirement (see Applicant's Response of 5/31/2005 ppg. 9-13; Applicant's Response of 11/22/2005 ppg. 9-14; Applicant's Response of 5/31/2006 ppg. 9-10; Applicant's Response of 10/20/2006 ppg. 9-10).

In order to substantiate the restriction requirement the Examiner is obligated to show one way distinctness; that is, either how the process of claim 1 can be used to make a materially different product than claims 25 and/or 30, or how the product of claims 25 and/or 30 can be made by a materially different process than claim 1. (MPEP 806.05(f),

see Office Action of 3/1/2006, pg. 2) The Examiner says he has met that obligation but cannot point specifically in the record where he did so; he simply states that he did so in the Office Actions of 3/1/2006 and 8/22/2005¹ (Advisory Action of 11/7/2006; Office Action of 8/21/2006 pg. 2).

Applicant has rebutted the Examiner's basis for the restriction requirement provided in the Office Action of 8/22/2005. The Examiner's steadfast refusal to acknowledge Applicant's rebuttal is reversible error.

Particularly, in the Office Action of 8/22/2005 the Examiner's basis for maintaining the restriction requirement of groups I and II was that the method of claim 1 "can occur without any rotary shear or without rotation, to provide a concentric alignment." Applicant rebutted that argument by pointing out that the claim language *placing prewritten discs...disposing the angular reference axes symmetrically around the motor hub* in fact expressly requires rotation of the discs (see Applicant's Response of 11/22/2005, ppg. 9-12).

Furthermore, in the Office Action of 8/22/2005 the Examiner's basis for restricting groups I and III and groups II and III was his reading of claim 30 to mean the servo information was "on the motor" instead of "on the discs." Applicant traversed the Examiner's construction as unreasonable, but nevertheless amended claim 30 to more particularly point out and distinctly claim *stacking...discs with prewritten servo information ~~on~~ onto the motor* (see Applicant's Response of 11/22/2005, ppg. 13-14).

Therefore, the Examiner's recent statements that he substantiated the restriction requirement in the Office Action of 8/22/2005 wholly ignores the fact that Applicant has

¹ The Advisory Action of 11/7/2006 and Office Action of 8/21/2006 actually refer to the "previous Office Actions mailed on March 1, 2006 and August 22, 2006." However, Applicant believes this is a mistake, and that the Examiner is actually referring to the previous Office Actions of 3/1/2006 and 8/22/2005.

rebutted that reasoning as being without merit or obviated. Simply saying he has substantiated the restriction requirement is not sufficient in the law, he must be able to point in the record where he actually did substantiate it. The Examiner's maintaining the restriction requirement by ignoring Applicant's rebuttal of it is reversible error from which Applicant now seeks relief.

Similarly, Applicant has rebutted the Examiner's basis for the restriction requirement provided in the Office Action of 3/1/2006. The Examiner's steadfast refusal to acknowledge Applicant's rebuttal is reversible error.

Particularly, in the Office Action of 3/1/2006 the Examiner's basis for maintaining the restriction requirement was simply that group I claims are directed to a method and groups II and III are directed to an apparatus. Applicant rebutted the Examiner's basis because it wholly ignores the Examiner's obligation to show one way distinctness; that is, to show either how the process of claim 1 can be used to make a materially different product, or how the products of claim 25 and 30 can be made by a materially different process. (MPEP 806.05(f)) The mere fact that some claims are directed to a method and other claims are directed to an apparatus does not, in and of itself, merit grounds for the restriction requirement.

Therefore, the Examiner's recent statements that he substantiated the restriction requirement in the Office Action of 3/1/2006 wholly ignores the fact that Applicant has rebutted that reasoning as being without merit. Simply saying he has substantiated the restriction requirement is not sufficient in the law, he must be able to point in the record where he actually did substantiate it. Maintaining the restriction requirement by ignoring Applicant's rebuttal is reversible error from which Applicant now seeks relief.

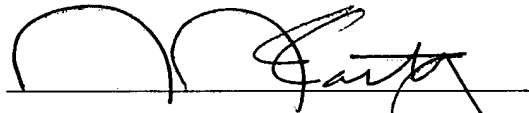
Conclusion

For the reasons above, Applicant respectfully requests that the Director intervene in this case to have the restriction requirement either withdrawn or substantiated by legally sufficient evidence in the record.

Applicant does not believe that there is a fee required with this petition. However, should a fee be required, please consider this paper authorization to charge our Deposit Account No. 06-0540 for such fee.

Respectfully submitted,

By:

A handwritten signature in black ink, appearing to read 'McCarthy', is written over a horizontal line.

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